

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-23 are now present in this application. Claims 1, 8 and 13 are independent.

Claims 21-23 have been added. No new matter is involved. Support for these new claims is found throughout Applicants' originally filed disclosure including, for example, in Fig. 2C, and from the last paragraph on page 6 to the first full paragraph on page 8 of the specification.

Amendments have been made to the claims. Claims 1, 8 and 13 have been amended to recite a manual switch feature. Claim 20 has been amended by changing "is" to --comprises--. No new matter is involved. Support for these amendments is found throughout Applicants' originally filed disclosure including, for example, in Fig. 2C, and from the last paragraph on page 6 to the first full paragraph on page 8 of the specification.

Reconsideration of this application, as amended, is respectfully requested.

I. Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for domestic priority under 35 U.S.C. § 119(e) to a provisional application.

II. Objection to the Drawings

The Examiner has objected to the drawings for failure to comply with 37 CFR §1.84(p)(5) in that remote control 60, described in the specification, is not shown in the drawings.

In order to overcome this objection, Applicants are concurrently submitting a replacement drawing sheet for the Examiner's approval, which addresses the deficiency pointed out by the Examiner. In particular, Applicants have amended Fig. 2C to illustrate a remote control 60. No new matter is involved. Adequate basis for this amendment is found throughout Applicants' disclosure as originally filed including, for example, from page 8, line 5 to page 9, line 4 of the specification.

Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

III. Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 15 and 20 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language lacks antecedent basis or is not clearly understood.

Applicants respectfully submit that the claims, as they stand, particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With respect to claim 15, which recites that the "hydraulic motor" is a hydraulic cylinder, claim 15 depends from claim 13 which positively recites "hydraulic motor" both in the preamble and in the last line of claim 13. Either recitation of "hydraulic motor" in claim 13 provides proper antecedent basis for the same term in claim 15.

With respect to claim 20, which recites that the "hydraulic device" is a bottom dumping container, claim 20 depends from claim 13 which positively recites "hydraulic device" both in the preamble and in the last line of claim 13. Either recitation of "hydraulic device" in claim 13 provides proper antecedent basis for the same term in claim 15.

Further, with respect to claim 20, Applicant respectfully submits that the meaning of the terminology "bottom dumping container" is clear and definite and reads on dumpsters, whether they be hydraulically operable or not, and is not limited to any specific disclosed embodiment of a bottom dumping container. Simply because the scope of a claim term is broad does not mean that it is vague and indefinite.

Nevertheless, Applicants have amended claim 20 by changing "is" to --comprises--. This amendment does not narrow the scope of the claim in any way and makes it clear that the hydraulic device includes a bottom dumping container.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

IV. Rejection Under 35 U.S.C. § 102

Claims 1-3, 6-10, 13-15 and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,858,728 to Fathauer. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants respectfully submit that independent claims 1, 8 and 13 have been amended to recite a manual switch feature. Applicants respectfully submit that the combinations of elements as set forth in independent claims 1, 8 and 13 are not disclosed or made obvious by the prior art of record, including Fathauer.

Applicants respectfully submit that Fathauer is completely devoid of any teaching of locating a manually operated switch located at its portable spreader unit that is suspended from a

crane. This feature is neither disclosed nor in any way suggested by Fathauer.

Applicants respectfully submit that the combinations of elements as set forth in independent claims 1, 8 and 13 are not disclosed or made obvious by the prior art of record, including Fathauer. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

With regard to dependent claims 2, 3, 6, 7, 9, 10, 14, 15 and 17-19, Applicants submit that claims 2, 3, 6 and 7 depend, either directly or indirectly, from independent claim 1 which is allowable for the reasons set forth above, that claims 9-10 depend, either directly or indirectly from claim 8 which is allowable for reasons stated above, and that claims 14, 15 and 17-19 depend, either directly or indirectly, from claim 13, and therefore claims 2, 3, 6, 7, 9, 10, 14, 15 and 17-19 are allowable based on their dependence from one of the aforementioned independent claims. Reconsideration and allowance thereof are respectfully requested.

V. Rejections under 35 U.S.C. §103

Claims 4, 5, 11, 12, 16 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fathauer in view of prior art shown in Fig. 1 of this application. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant Application, Applicants respectfully submit that independent claims 1, 8 and 13 have been amended to recite a manually operated switch feature, as discussed above regarding the rejection of claims 1-3, 6-10, 13-15 and 17-19. Applicants respectfully submit that the combinations of elements as set forth in independent claims 1, 8 and 13 are not disclosed or made obvious by the prior art of record, including Fathauer and/or the prior art of Fig. 1 of this Application.

With regard to dependent claims 4, 5, 11, 12, 16 and 20, Applicants submit that claims 4, 5, 11, 12, 16 and 20 depend, either directly or indirectly, from one of independent claims 1, 8 and 13 which are allowable for the reasons set forth above, and therefore claims 4, 5, 11, 12, 16 and 20 are allowable based on their dependence from one of claims 1, 8 and 13.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention because it does not provide proper motivation for one of ordinary skill in the art to combine the references, as asserted.

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Additionally, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action alleges that one of ordinary skill in the art would be motivated to combine these references because (1) both devices exist in the prior art, (2) Fathauer's device causes "the movement of arms (12) to grip a container (13)", and (3) the prior art of Fig. 1 shows "a hydraulic dumpster having a hydraulic cylinder (19,19) causing to open or close the pivotal doors."

These are nothing more than broad conclusionary statements of the type expected in Dembiczak, supra, and present no evidence of why it would be obvious to modify the prior art device of Fathauer in view of Fig. 1 and arrive at the claimed invention. In effect, the rejection just says it would be obvious to do so because it would be obvious to do so.

Moreover, Fathauer's invention dates from 1974-1975. That is approximately thirty years ago. If it were so obvious to combine the teachings of the admitted prior art and Fathauer, then the Office Action should explain why it apparently was not obvious to skilled workers to so modify the admitted prior art in that almost 30 year time period.

Because the Office Action has not presented any objective evidence of proper motivation to combine these references as suggested, it fails to make out a *prima facie* case of obviousness of the claimed invention recited in claims 4, 5, 11, 12, 16 and 20. Accordingly, the rejection is improper and should be withdrawn.

Reconsideration and allowance of claims 4, 5, 11, 12, 16 and 20 are respectfully requested.

VI. Claims 21-23

Claims 21-23 have been added for the Examiner's consideration. Applicants submit that claims 21-23 depend directly

from one of independent claims 1, 8 and 13, and are therefore allowable based on their dependence from one of claims 1, 8 and 13, all of which are believed to be allowable for reasons stated above.

Consideration and allowance of claims 21-23 are respectfully requested.

VII. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a three-month(s) extension of

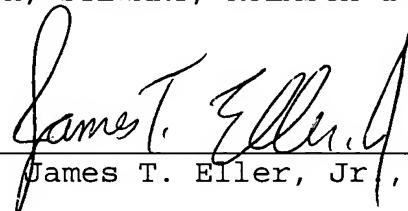
time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$475.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:


James T. Eller, Jr., #39,538

JTE/RJW:jao:trb

P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000

Attachment: Replacement Drawing Sheet